BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of Court Below.

The Findings of Fact and Conclusions of Law of the District Court are found at pages 2085-2099 of the Record, Volume III; the opinion of the District Court is found at pages 2100-2119, officially reported in 29 F. Sup. 516; and the Interlocutory Decree of the District Court at pages 2120-2121 of the Record.

The Opinion of the Circuit Court of Appeals (before Circuit Judges Simon, Allen and Hamilton, Judge Allen writing) appears at pages 2882-2891 of the Record and is reported in 124 F. (2d) 865.

Jurisdiction.

The Decree of the Circuit Court of Appeals was entered January 13, 1942, and appears at page 2881; the Petition for Rehearing appears at 2892-2916; and the Order denying the Petition for Rehearing, entered March 5, 1942, appears at page 2917.

Statement of the Case.

The foregoing Petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as a statement of the questions involved in the case.

Specification of Errors.

I.

That the Court of Appeals erred in holding the Berry patent invalid on the same ground upon which respondents had attempted unsuccessfully to persuade the Patent Office

to hold the subject matter unpatentable in the Interference proceedings.

II.

That the Court of Appeals erred in concluding that the District Court had read "oval grinding" into the claims of the patent in suit.

III.

That the Court of Appeals erred in failing to read claim 35 of the Berry patent in the light of its specifications.

IV.

That the Court of Appeals erred in holding that the Berry patent differed from the prior art merely in the substitution of materials.

V.

That the Court of Appeals erred in reversing and not affirming the Decision of the District Court.

ARGUMENT.

I.

The Court of Appeals Permitted Respondents to Relitigate a Question Which Had Been Determined in Favor of Berry in Previous Proceedings, Contrary to this Court's Decision in Radio Corp. v. Radio Lab., 293 U. S. 1.

The purpose for the granting of the patents is, of course, found in the Constitution (Art. 1, Sec. 8), namely, "to promote the progress of science and the useful arts"; and one who does that should naturally be favored by the law and secure the fruits of his invention. As this Court said in *U. S.* v. *Dubilier Corp.*, 289 U. S. 178, 186:

> "An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of

value to the community by adding to the sum of human knowledge."

In *Mumm* v. *Decker & Sons*, 301 U. S. 168, 171, this Court cited with approval a number of early cases dealing with the presumption raised by the grant, and that the burden is upon the defendant to overcome that presumption; this Court said:

> "• • • Not only is the burden to make good this defense upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him.' Id., Cantrell *v.* Wallick, supra; Coffin *v.* Ogden, 18 Wall. 120, 124; Barbed Wire Patent, 143 U. S. 275, 284, 285; Adamson *v.* Gilliland, 242 U. S. 350, 353."

The presumption raised by the grant is, however, strengthened by the fact that the prior art was before the Examiner, particularly where it has been subjected to the opposition of counsel in interference proceedings; *Hildreth* v. *Mastoras*, 257 U. S. 27, 32:

> "This, as already said, is the claim which was framed in the Patent Office as the issue of the interference proceeding, and of which Dickinson was given priority over all. The presumption of priority and novelty which arises from the granting of a patent must have greatly increased weight when the claim of the inventor is subjected to such close and careful scrutiny under the stimulus of a heated contest."

When a suit for infringement is preceded by an interference proceeding between the same parties on the same subject matter, the presumption of validity is strengthened to conclusiveness. As the court, through Mr. Justice Cardozo, said in *Radio Corp.* v. *Radio Lab.*, 293 U. S. 1:

> "For the purpose of any controversy between Armstrong and DeForest *the validity of* the patents *must be accepted as a datum.*" (l. c. 2)

In that case Armstrong and DeForest had contested an interference and hence were in the position respectively of Nelson and Berry here.

> "The outcome of their contest was—binding on the claimants and their several assignees".

In the interference proceeding between Nelson (Bohn Corp.) and Berry, the Patent Office tribunals considered, on Motions of Nelson and Jardine (R. 2224-2246, 2268-2275, 2282-4) the Ricardo patent, the Nelson single and duplicate middle strut patents and the Napier patent. Yet the Court of Appeals held the Berry patent invalid as involving a mere substitution of materials in Ricardo (R. 2890). Significant is the fact that this very argument was advanced, without success, in attacking patentability in the interference (R. 2231, 2273). The Court of Appeals seemed to attach significance to the fact that Berry frankly admitted having heard Nelson read the paper suggesting the possibility of a steel strut. But the paper was also before the Patent Office and, in answer to Nelson's contention that he "disclosed the invention to Berry by a paper" (R. 2265), the Board of Appeals held:

> "The paper does not disclose the invention in issue."

Respondents have, therefore, had their day in court on the very point upon which the Circuit Court of Appeals based its decision. They failed before. They should not be permitted to reopen the question (at least in the absence of newly discovered non-cumulative evidence).

Regard for the doctrine of finality of judgments would seem to foreclose respondents from attacking validity on the grounds urged in the previous proceeding.

Such was the effect of *Radio Corp.* v. *Radio Lab., supra.* The rule was not altered by *Schriber-Schroth* v. *Cleveland Trust Company,* 305 U. S. 47, because there the question

previously determined in an interference was relitigated by a stranger to the interference proceeding.

II.

The District Court Did Not Read Cam or Oval Grinding into the Claims of the Berry Patent.

There were three accused pistons, namely, Ex. 302, the Packard narrow-strut, Ex. 303, the Dodge Wide Strut, and Ex. 304, the Autothermic. Only the Autotholermic was cam ground oval, while the other two were ground round or circular (R. 94); the Court of Appeals so said as to the narrow-strut piston (R. 2888). The District Court concluded both of these round ground pistons were infringements of the Berry claims in issue (R. 2095-6 and R. 2120), and the Court of Appeals distinctly said as to all of the accused pistons (R. 2885):

> "We conclude that the District Court correctly found that the accused pistons infringe if the Berry patent is valid".

Obviously the Court of Appeals was in error when it held (R. 2888):

> "We conclude that the District Court read into the claims in issue as an essential element the requirement that the thrust surface should be 'cam ground.' This was not revealed in the drawings, the specifications, or the claims, and therefore the patent held to be valid was neither claimed nor granted. Altoon *v.* American Tri-Ergon, 294 U. S. 477, 487; Schriber-Schroth *v.* Cleveland Trust Co., supra; Permutit Co. *v.* Graver Corp., 284 U. S. 52."

It is true Judge Tuttle discussed cam grinding with the witnesses and counsel during the trial, but nowhere did he consider cam or oval grinding an "essential" feature of the Berry patent structure, but at most that this Berry

structure had the potencies, capacities, advantages and capabilities that it could be cam ground; *Radio Corp.* v. *Radio Lab.*, 293 U. S. 1, 12, 14; *Webster Loom Company* v. *Higgins*, 105 U. S. 580; recently approved in *Honolulu* v. *Halliburton*, 306 U. S. 550, 559. It was not even mentioned by Judge Tuttle in his discussion of the claims in his Opinion (R. 2117-8), and not at all in his findings (R. 2095-6). The position of Petitioners' counsel and the understanding of Judge Tuttle are clearly shown by the following colloquy at the trial (R. 1653):

> "The Court: You say I am not concerned with whether or not—I don't know whether they have got a patent now that calls for cam-grinding, or whether that is an improvement of yours, or whether it is old, or what-not, because that cam-grinding business is not in your patent at all.
>
> "Mr. Bruninga: No, it isn't described, but anyone skilled in the art, producing a piston like that, and finding it bearing at the corners, would immediately resort to it. That is the thing. And that is permissible by the art. It don't mean we apply for a patent on that thing for the use of cam-grinding, or a thing like that. We don't claim the patent for that would even be considered by the Patent Office as something patentable. There is nothing in that at all."

The situation is, therefore, one where the Court of Appeals, at the instance of Respondents' counsel, has set up a straw man, which was then knocked down by the doctrine of *Schriber-Schroth* v. *Cleveland Trust*, 305 U. S. 47.

III.

The Court of Appeals' Decision Holding Claim 35 Invalid is Contrary to the Decision of this Court in Schriber-Schroth v. Cleveland Trust, 311 U. S. 211.

The Court of Appeals' Decision is so clearly contrary to the decision of this Court in *Schriber-Schroth* v. *Cleve-*

land Trust, 305 U. S. 47, that it will be only necessary to quote claim 35 of the Berry patent in connection with claim 8 of the Jardine patent there in suit.

Berry claim 35 (R. 2161) reads as follows:

> "35. A piston having a head, piers depending from the head, piston pin bearings formed in the piers, cylinder-bearing portions on opposite sides of the piston, a pair of chordal struts, each of said struts extending between the cylinder-bearing portions, the intermediate portion of each strut being surrounded by the material of a pier, there being an integral connection between each of the cylinder-bearing portions and each pier."

Jardine claim 8, 311 U. S. 211, 218:

> "8. In a piston for an internal combustion engine, the combination of a head having a cylindrical ring flange, oppositely disclosed webs integral with the flange and carrying diametrically opposite piston pin bosses, skirt integral with said webs and cut away to expose the sides of said webs and separated from the ring flange by circumferential slits and provided with a longitudinal slit disposed between the ends of the webs."

This Court said, 311 U. S. 211, 217:

> "The claims of a patent are always to be read or interpreted in the light of its specifications, Hogg *v.* Emerson, 11 How. 587; Carnegie Steel Co. *v.* Cambria Iron Co., 185 U. S. 403; Smith *v.* Snow, 294 U. S. 1; and we may assume that if in the present case the specifications and claims of the patent were to be interpreted without reference to its file wrapper history, the webs referred to in the claims are the webs described in the specifications as capable of bending in cooperation with the slotted piston guides or skirts so as to compensate for thermal expansion and so supply the element of webs laterally flexible which was wanting to Gulick and to Maynard."

It is not necessary to even paraphrase this Court's language to show that the situations in the two cases were identical; except that here there was no file wrapper history restriction in this respect, because there was no substantial amendment to the Berry application as filed and claim 5 of the patent was original claim 8 (R. 2473-80).

IV.

The Berry Patent Piston Does Not Involve Merely a Substitution of Materials, but Involves a New Combination.

This case is not as broad as a mere substitution of materials, as was the Door Knob Case, *Hotchkiss* v. *Greenwood*, 11 Howard 248, involving merely the making of a door knob of clay or porcelain, instead of iron, brass, wood or glass. This case is much narrower, because the Berry patent involves a combination in which the factor of substitution of materials is only one factor; for the steel struts are so positioned and combined with the aluminum thrust faces and aluminum boss piers, as to produce an entirely new piston structure having properties and capabilities not possible with prior art pistons.

This case is on all fours with the Tooth Plate case, *Smith* v. *Goodyear Dental Vulcanite*, 93 U. S. 486, the patented structure of which this Court said, l. c. 492:

> " 'consists in forming the plate to which the teeth, or teeth and gums, are attached, of hard rubber, or vulcanite, so called, an elastic material, possessing and retaining in use sufficient rigidity for the purpose of mastication, and at the same time being pliable enough to yield a little to the motions of the mouth.' "

Of this combination this Court said, l. c. 494:

> "* * * A new product was the result, differing from all that had preceded it, not merely in degree of

> usefulness and excellence, but differing in kind, having new uses and properties."

In distinguishing from the Door Knob Case, which involved the complete substitution of clay or porcelain for iron, brass, or wood, this Court said, l. c. 496-7:

> "It does not decide that no use of one material in lieu of another in the formation of a manufacture can, in any case, amount to invention, or be the subject of a patent. If such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention.
>
> "* * * But where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes."

While the Tooth Plate case has been applied by this Court in only one subsequent case, involving the question of substitution of materials, *Magowan* v. *New York Belting Co.*, 141 U. S. 332, where the patent was held valid, it has recently been cited and applied in other Circuits in upholding the validity of combination patents, involving this question, as follows: *United Shoe Machinery Co.* v. *Ferree*, 64 F. (2) 101, 103, C. C. A. 2; *Tyra* v. *Adler*, 85 F. (2) 548, 552, C. C. A. 8; *Gasoline Products Co.* v. *Coe*, 87 F. (2) 550, 557, App. D. C.

This Court (93 U. S. 495) considered the factors that there was a problem in the art (as the Court of Appeals found here, R. 2885), and that the patented combination had solved that problem as evidenced by its commercial success (as we have here). That others in the field sought to solve the problem has been considered a factor by this court, in determining whether inventive ingenuity was involved;

Potts v. *Craeger*, 155 U. S. 597, 607; so has the fact that defendant has copied the patented structure even though the art had alternatives; *Diamond* v. *Consolidated*, 220 U. S. 428, 441. These and other factors, previously noted, were not given any weight by the Court of Appeals in this case.

Judge Tuttle's Findings 18, 19 and 20 (R. 2092) were arrived at after hearing, seeing and examining witnesses and witnessing demonstrations for twenty-six days. His finding that the Berry "combination was not obvious to those skilled in the art and required more than mechanical skill", was supported by the highly qualified Stellmann, after consideration and discussion of the entire prior art, not only on direct examination (R. 2045-6), but also on cross examination (R. 2075-6). That was not disputed by any one skilled in this art. This was really a question of fact which is properly a finding; *St. Paul Plow Works* v. *Starling*, 140 U. S. 196-7; particularly where the trial court not only heard and saw the witnesses, but witnessed demonstrations; *United States* v. *United Shoe Machinery Company*, 247 U. S. 32, 38 Sup. Ct., l. c. 476.

The only prior art not discussed by the Patent Office tribunals were the Knight and Hartog patents; the latter was issued to Cleveland Trust, and its application (467,587) was included in the patent pool (R. 2678), as was also (R. 2679) the Napier patent. Judge Tuttle classed them together in his finding (R. 2090) as follows:

> "But this ring was only below the wrist pin boss and not at the top, where it is most necessary to control expansion, and was little more than an iron cylinder with aluminum around it—and a heavy iron cylinder, at that."

This finding is fully supported by the experienced and practical Stellmann, (R. 1855-8) who was examined by Judge Tuttle on such structures. Stellmann cited his ex-

perience with such a piston in the Franklin automobile; Nelson's own patents 1,161,709 (R. 2452, lines 82-99, and R. 2350, lines 99-110), show the impracticability of such a piston having such a necessarily heavy ring. That, of course, includes Hartog, as well as Napier and Knight, all of which are simply cumulative.

It is respectfully submitted that the evidence we have here is no different than before the Primary Examiner and the Law Examiner. The worthless and impractical iron ring devices of the Knight and Hartog pistons are simply cumulative of that of Napier considered by the Law Examiner. Even the Board of Appeals decided (R. 2265) that the Nelson publication did not "disclose the invention in issue" to Berry, who heard that paper, which hearing of the paper the Court of Appeals for some reason considered significant (R. 2889). The Findings of Judge Tuttle are entitled to the full force and effect contemplated by Civil Rule 52 (a), and should not have been set aside.

Conclusion.

As this Court recognized in the Piston Cases, 305 U. S. 47, 49, due to the concentration of the automobile industry in the Sixth Circuit, litigation elsewhere is improbable. Petitioner Berry resides in the same circuit (R. 1416). While we are at war, and while the manufacture of automobiles stopped shortly after the decision of the Court of Appeals, the questions raised in this Petition are still important.

It is important, during even the present period, that the progress of science and the useful arts be promoted, and that inventors be encouraged to use their ingenuity to promote that progress to make inventions. It is, therefore, important that the incentive to reward provided for in the Constitution and enacted in our Patent Statutes be kept burning.

This case is one of the most outstanding instances of the trials and tribulations of an inventor that we can find in the annals of invention. Berry, a professor, with the finances of such a man, made a contribution to an art, which was crying for something to solve the problem encountered. That he did so is evidenced by the tremendous commercial acceptance of his invention. After the usual delays before the Primary Examiner, he succeeded in securing allowance of his claims. But then he was faced with expensive and delaying interferences proceedings, by interlopers whose filing dates were from one to two years subsequent to his, and who, when all is said and done, derived their knowledge from Berry. After these very interlopers would not even deign to "make an offer", he turned to General Motors, who was willing to contract on a basis to give the inventor the complete control of the patent rights, and pay the expenses of the interference proceeding which the inventor did not have a chance to combat alone.

Now after years of exploitation of Berry's invention, while respondents were protected by the umbrella of a pool of patents, most of which were later found to be invalid, and after seeking to bring Berry's invention under that umbrella by their own applications, the respondents say that Berry's invention was obvious to any one skilled in the art. And they so contend, even though when they were trying to cover the Berry piston, they considered its patent worth alone, from twenty cents to thirty-five cents per piston, and they sold thirty-five million of those pistons.

The observation of this Court, years ago in the *Barbed Wire Patent* case, 143 U. S. 275, on another phase of seeking to appropriate inventions, is apropos, when this Court said l. c. 284:

> "* * * The very fact, which courts, as well as the public, have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to

the one under consideration, has been attacked by testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny. Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defence of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

Berry is entitled to the benefits of the patent laws based, as they are, on the Constitution. That is all he asks for as a reward for his contribution to this art, and as an incentive to other inventors.

Respectfully,

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